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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,847	07/28/2003	James Jannard	NOCODE2.005C3	6079
20995 7590 08/24/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER DANG, HUNG XUAN	
			ART UNIT 2873	PAPER NUMBER
			NOTIFICATION DATE 08/24/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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## Office Action Summary

Application No.

10/628,847

Applicant(s)

JANNARD ET AL.

Examiner

Hung X. Dang

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The amendment filed on 5/30/07 has been entered.

### **Claims Rejection Under 35 USC - 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-21, 30, 31, 34, 35 and 38-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) in view of **Bylander** (5,654,786).

Swab et al discloses eyewear with exchangeable temples housing a transceiver forming AD HOC networks with other device comprises eyeglass frame having an interactive device electronic device support by the frame (see figure 1 and the related disclosure).

Swab et al does not disclose the lens configured to have variable light attenuation.

Bylander, however, discloses the lens 50 configured to have variable light attenuation.

Because Swab et al and Bylander are both from the same field of endeavor, the purpose of controlling the amount of light that is transmitted through the lens as disclosed by Bylander would have been recognized as an art pertinent art of Swab et al.

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It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Swab et al, with the lens configured to have variable light attenuation, such as disclosed by Bylander for the purpose of controlling the amount of light that is transmitted through the lens.

### **Claims Rejection Under 35 USC – 103**

3. Claims 14-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) in view of **Young** (4,149,780).

Swab et al discloses eyewear with exchangeable temples housing a transceiver forming AD HOC networks with other device comprises eyeglass frame having an interactive device electronic device support by the frame (see figure 1 and the related disclosure).

Swab et al does not disclose the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position.

Young, however, discloses the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position (see figure 1 and the related disclosure.)

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Because Swab et al and Young are both from the same field of endeavor, the purpose of controlling the amount of light that is transmitted through the lens as disclosed by Young would have been recognized as an art pertinent art of Swab et al.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Swab et al, with the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position, such as disclosed by Young for the purpose of controlling the amount of light that is transmitted through the lens.

#### **Response To Applicant's Argument**

4. Applicant's arguments filed 5/30/07 have been fully considered but they are not persuasive.

Applicant argued that "Applicants respectfully submit that neither the combination of Swab and Bylander nor the combination of Swab and Young justify an obviousness rejection of any of Claims 14-34 and 36-50. As discussed below, these references do not provide any apparent reason to combine the components recited in these claims.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the purpose of controlling the amount of light that is transmitted through the lens as disclosed by Bylander would have been recognized as an art pertinent art of Swab et al.

Applicant argued that "It is first noted that none of Swab, Bylander, or Young teach a coupling or speaker support that is "configured such that the speaker may be pivoted over a predetermined distance with respect to the frame," as recited in each of independent Claims 14, 22, and 38. Indeed, Bylander and Young are devoid of any discussion of the use of speakers or related equipment in their eyewear products. Further, as discussed below, Swab also fails to disclose the above-noted features of these claims." This argument is not persuasive because at least figures 8 and 10 of Swab show that a pair of speakers 60 and 62 being pivot over a predetermined distance with respect to the frame to position the speaker adjacent the user's ear when worn by the user. Therefore the claimed invention does not distinguish over the cited art.

5. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

8/07



HUNG DANG

PRIMARY EXAMINER

TC 2800